

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARTIN E. DOWZALL and VAZGEN J. HOUSSIAN

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Appeal No. 97-2148  
Application 08/295,829<sup>1</sup>

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ON BRIEF

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Before ABRAMS, STAAB and McQUADE, *Administrative Patent Judges*.  
STAAB, *Administrative Patent Judge*.

#### DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-12, all the claims in the application. We reverse.

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<sup>1</sup> Application for patent filed October 12, 1994. According to appellants, this application is a national stage application under 35 U.S.C. § 371 of PCT/GB93/00510 filed March 11, 1993.

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Appellants' invention pertains to an auxiliary nib unit having a relatively thin nib for use in conjunction with a marker implement having a relatively broad nib. When attached to the marker implement, the relatively thin nib of the auxiliary unit engages the nib of the marker implement to convert the implement into one having a finer nib. Independent claim 1, a copy of which is appended to appellants' brief, is exemplary of the claimed subject matter.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Yokosuka et al. (Yokosuka)	4,913,175	Apr. 3, 1990
Ayme (British Patent)	1,005,487	Sept. 22, 1965
Levasseur (French Patent)	2,489,753	Mar. 12, 1982
Fukui (British Patent)	2,148,200	May 30, 1985

Claims 3, 5, 11 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (answer, page 3).

Claims 1-8, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ayme in view of Fukui and Yokosuka.

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Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ayme in view of Fukui and Yokosuka, and further in view of Levasseur.

The full text of the examiner's rejections and response to the argument presented by appellants appears on pages 3-6 of the answer.

The opposing viewpoints of appellants are set forth on pages 5-14 of the brief.

*The Rejection under 35 U.S.C. § 112, Second Paragraph*

We will not sustain the rejection of claims 3, 5, 11 and 12 under 35 U.S.C. § 112, second paragraph.

Independent claim 1, from which rejected claims 3, 5, 11 and 12 depend, is directed to a nib conversion unit *per se* and does not positively recite the main nib of the marker implement as a part of the claimed conversion unit. Nevertheless, dependent claims 3, 5, 11 and 12 each further describe, in one way or another, the main nib of the inferentially recited marker implement. For example, claim 5 reads "A nib unit as claimed in claim 1, in which *the main nib* is formed from a plastics material" (emphasis added).

In explaining the 35 U.S.C. § 112, second paragraph, rejection of these claims, the examiner makes the following statement:

Claims 3, 5, 11 and 12 appear to be properly rejected under office guidelines concerning combination/subcombination claims.<sup>[2]</sup> The combination of the nib unit and main nib is only positively claimed in claims 8-10. The main nib is only recited in the preamble in claim 1. [answer, page 4]

It thus appears that the examiner's rejection is based on a belief that the dependent claims do not pass muster under the second paragraph of 35 U.S.C. § 112 because they do not place a further limitation on the positively recited nib conversion unit.

While the second paragraph of 35 U.S.C. § 112 requires that a claim must particularly point out and distinctly claim the subject matter sought to be patented, it does not require the claims to be in any particular form. In the present instance, the examiner does not appear to have any difficulty understanding the meaning of the claim language in question. Nor do we. Instead, the examiner appears to take issue with the form of the claims. However, in the absence of a clear explanation of how the claim format results in a failure to particularly point out

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<sup>2</sup> The examiner has not specifically identified, and it is not apparent to us, what "office guidelines" he is relying on in support of his position.

and distinctly claim the subject matter sought to be patented, the examiner's position is not well taken.<sup>3</sup>

*The Rejections under 35 U.S.C. § 103*

We will not sustain the rejection of claims 1-12 under 35 U.S.C. § 103.

There appears to be no dispute that Ayme discloses the subject matter of claim 1 except that the nib 14 of the auxiliary nib unit is not movable axially of the auxiliary nib unit housing, as called for in claim 1. According to the examiner, it would have been obvious to mount Ayme's nib 14 for axial movement in the auxiliary housing in view of the teachings of Fukui and Yokosuka, the motivation for so doing "[being] provided by the secondary patents" (answer, page 4, line 1) and "to reduce wear on the nib" (answer, page 4, last line).

Fukui discloses a marker having a single needle-like nib 2 mounted for axial sliding movement within a nib holder pipe 1. The interior end of the nib 2 has bent sections 2a, 2b on each end of a section 2c generally transverse to the nib. The bent

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<sup>3</sup> We note that the rejection here is not under the fourth paragraph of 35 U.S.C. § 112, which requires a dependent claim to further limit the claim from which it depends. In any event, the dependent claims in question further limit the subject matter of independent claim 1 in the sense that they further describe or limit the nib of the marker implement with which the claimed conversion unit is to be used.

sections resiliently support the nib to permit it to move axially within the holder pipe. Yokosuka discloses a liquid applying device comprising a spring loaded actuator valve 41, and an axially slidable liquid-applying member 3 for unseating the valve so that liquid can flow forwardly from the reservoir 45 to the tip of the device when it is desired to apply liquid.

In our view, the combined teachings of the applied references would not have suggested mounting Ayme's nib 14 for axial movement in the auxiliary nib unit housing. The mere fact that Fukui and Yokosuka disclose nib portions which are slidably mounted is not sufficient in this regard. In Fukui, the purpose for mounting the needle-like writing nib 2 for axial movement in the holder pipe 1 is not entirely clear, although it may be inferred that it helps to keep the holder pipe free of debris (page 2, lines 79-81) and facilitates the smooth flow of ink along the nib (page 2, lines 125-126). In Yokosuka, the purpose for mounting the liquid-applying member 3 for axial movement is to open the valve 41, which in turn causes the liquid in the reservoir 45 to flow forwardly so that the application of liquid can be achieved (column 2, lines 61-68). Neither of these references, however, describe any advantage to having an axially slidable nib that would appear to be applicable to Ayme. In the

same vein, Ayme provides no hint that such an arrangement might be beneficial. Accordingly, the examiner's statement that the motivation for the proposed combination is found in the secondary references is not understood. Likewise, the examiner's rationale that mounting the nib of Ayme's auxiliary nib unit for axial movement "to reduce wear on the nib" has no basis in the applied references and is, at best, speculative. In this light, it is apparent that the examiner has engaged in an impermissible hindsight reconstruction of the claimed invention wherein the appellants' claims have been utilized as a template to selectively piece together isolated disclosures in the prior art. We therefore cannot sustain the 35 U.S.C. § 103 rejection of claims 1-8, 11 and 12 as being unpatentable over Ayme in view of Fukui and Yokosuka.

As to the Levasseur reference additionally cited by the examiner against claims 9 and 10, we have carefully reviewed this reference but find nothing therein which makes up for the deficiencies of Ayme, Fukui and Yokosuka discussed above. Thus, we also cannot sustain the 35 U.S.C. § 103 rejection of claims 9 and 10.

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*Summary*

The 35 U.S.C. § 112, second paragraph, rejection of claims 3, 5, 11 and 12 is reversed.

The 35 U.S.C. § 103 rejection of claims 1-12 is reversed.

The decision of the examiner is reversed.

*REVERSED*

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	



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Darby and Darby  
805 Third Avenue  
New York, NY 10022